

REMARKS

Claims 9-16 and 24-30 were examined. All claims were rejected. In response to the above-identified Office Action, Applicants amend claims 9 and 11, cancel claims 31-34, and add new claims 35 and 36. Reconsideration of the rejected claims in light of the aforementioned amendments and the following remarks is requested.

I. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 15, 16 and 24-28 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application No. 2002/0138471 by Dutta *et al.* ("*Dutta*") in view of U.S. Patent Application No. 2004/0193900 by Nair ("*Nair*").

As to claim 9, that claim recites a system comprising, *inter alia*, a query device adapted to request a list of shared files from a plurality of computers connected to the network, and a transfer device adapted to passively transfer the list of shared files from each computer of the plurality of computers to the database. These limitations are absent from the references of record.

Dutta discloses a method for directing a search executed in a peer-to-peer network so that nodes that have returned good results in the past are searched earlier than nodes that have not returned good results. In *Dutta*, no list of shared files is transferred to the database (whether passively or not). Instead, *keywords from completed search queries* are indexed into the client rating database (*see* ¶0059), while no specific disposition of the list of query hits is described. (One can infer that the user of *Dutta*'s system selects and retrieves individual files on the list of query hits, but this is clearly different from passively transferring the list of shared files to a database, as claim 9 requires.)

Nair is relied upon for its alleged teaching of passive transfer of the list of shared files, but a review of the cited portion (*see* ¶0009) shows that *Nair* actually suggests one computer broadcasting its list of music files to a centralized computer, or broadcasting its ability to share files. *Nair*'s brief mention of the broadcasting operation fails to suggest how the automatic broadcast fits smoothly – or even roughly – into *Dutta*'s system. *Dutta* does not receive broadcasts of lists of music files; instead, it receives unicasts of lists of query hits from individual nodes to which the query was transmitted.

A broadcast according to *Nair* would be useless to *Dutta*, since *Dutta* is concerned with correlating query keywords with peer nodes that respond to those keywords. Accordingly, there is no motivation to combine such features of *Nair* with the methodology in *Dutta*.

For at least the foregoing reasons, Applicants respectfully submit that claim 9 is not obvious over the references of record, and request that the Examiner withdraw the rejection.

As to claims 10-12, 15 and 16, those claims depend directly or indirectly upon claim 9, and are patentable for at least the reasons discussed in support of that claim. Applicants respectfully request that the Examiner withdraw the rejections of these claims as well.

As to claim 24, that claim recites a method of tracking file storage on a file-sharing or peer-to-peer network, comprising a number of operations including requesting a listing of a library of shared files from each of a plurality of computers connected to the network and passively transferring the listing of the plurality of shared files from the computer to the database. *Dutta* does not teach transferring a listing of the plurality of shared files from the computer to the database, and *Nair*'s alleged teaching of passive transfer cannot properly be combined with *Dutta*. Therefore, Applicants submit that claim 24 is allowable over the references of record and request that the Examiner reconsider and withdraw the rejection.

As to claims 25-28, those claims depend directly or indirectly upon claim 24, and are patentable for at least the reasons discussed in support of their base claim. For at least those reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 25-28.

The Examiner rejected claims 13, 14, 29 and 30 under 35 U.S.C. § 103(a) as unpatentable over *Dutta* (*supra*) and *Nair* (*supra*), in view of U.S. Patent Application No. 2003/0105831 by O'Kane ("*O'Kane*"). The rejected claims depend directly or indirectly upon one of claim 9 or claim 24, base claims which were discussed and shown to be patentable over the cited references in the preceding paragraphs. *O'Kane* is relied upon for teachings related to report preparation, but even assuming for the sake of argument that *O'Kane* contains the alleged material, and that it may properly be combined with *Dutta* and *Nair*, Applicants have been unable to locate any teaching or suggestion in *O'Kane* that provides the material previously noted to be missing from *Dutta*, or that

explains how *Nair* might be combined with *Dutta*. Thus, for at least the reasons discussed in support of claims 9 and 24, Applicants respectfully submit that claims 13, 14, 29 and 30 are also allowable over the references of record, and request that the rejections be withdrawn.

II. New Claims

Applicants have added new claims 35 and 36, which are believed to describe with particularity material that Applicants regard as their invention. Support for the new claims is at, for example, ¶¶0079, 0099 and 00126 of the Application's Specification as filed. Thus, no new matter has been added.

Claim 35 is not taught or suggested by *Dutta* and *Nair* because neither of those references teaches or suggests establishing connections to a plurality of computers in a peer-to-peer network, requesting a list of files shared by each of the plurality of computers, obtaining from each of the plurality of computers the list of files shared by that computer, and storing the obtained plurality of lists in a database. Instead, *Dutta* stores lists of keywords from completed search entries in a client rating database, while *Nair* suggests computers broadcasting lists of files to a central computer (broadcasting is different than establishing a connection, requesting a list of files, and obtaining the list of files, at least because no connection is established and no request is sent to the broadcasting computer).

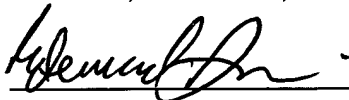
Consideration and allowance of the new claims is therefore respectfully requested.

CONCLUSION

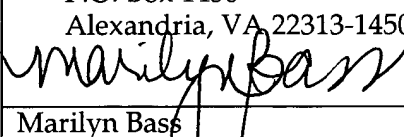
In view of the foregoing, it is believed that all claims now pending, namely claims 9-16, 24-30 and 35-36, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

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Respectfully submitted,
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